

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

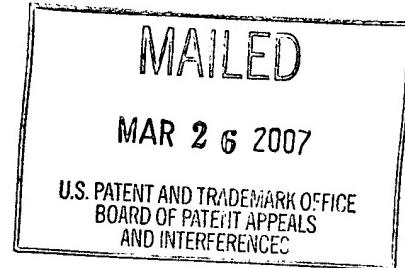
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte EDEL BERNADETTE O' TOOLE,
STEPHEN ROBERT SCHOFIELD, PAUL MEREDITH
and CHRISTOPER LAWERENCE GUMMER

Appeal 2007-0584
Application 10/049497
Technology Center 1600

ON BRIEF



Before GREEN, LINCK, and LEBOVITZ, *Administrative Patent Judges*.

Opinion by GREEN, *Administrative Patent Judge*.

Dissenting opinion by LINCK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-4 and 8-10. Claim 1 is representative of the claims on appeal, and reads as follows:

1. A hair care composition comprising:
 - a) at least one ester derivative of tyrosine;

- b) at least one other amino acid compound selected from tryptophan compounds, histidine compounds and lysine compounds; and
- c) a cosmetically acceptable carrier which is suitable for use on hair, said cosmetically acceptable carrier comprising one or more hair conditioning agents selected from the group consisting of silicone conditioning agents and cationic conditioning agents.

Claims 1-4 and 8-10 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Meybeck¹ and Kurokawa.² We reverse.

DISCUSSION

Meybeck is cited for teaching cosmetic conditions containing methyl tyrosinate, ethyl tyrosinate or stearyl tyrosinate, wherein the compositions increase the amount of melanin and thus the complexion of the hair (Answer³ 4). In addition, Meybeck teaches that cosmetic compositions containing tyrosinate salts retard graying of the hair. *See id.* According to the Examiner, “Meybeck does not teach at least one other amino acid and a hair-conditioning agent, as claimed.” *Id.* at 5.

Kurokawa is cited for teaching a hair cosmetic composition comprising quaternary ammonium conditioning compounds (cationic conditioning agents) and an amino acid selected from the group consisting of glycine, valine, histidine, tryptophan, threonine, *etc.* *Id.*

¹ Meybeck, US Patent No. 5,290,562, issued March 1, 1994.

² Kurokawa, JP 57-109711, published July 8, 1982 (as translated).

³ All references to the Answer are to the Examiner’s Answer dated May 5, 2006.

The Examiner concludes:

Accordingly, it would have been obvious for one of ordinary skill in the art at the time of the instant invention to combine the hair treatment composition of [Kurokawa], containing amino acids and hair conditioning agent, with the composition of Meybeck, which contains tyrosine methyl ester, . . . because while Meybeck suggests tyrosinate esters unexpectedly make it possible to obtain a measurable increase in the amount of melanin and thus help treat graying of hair, [Kurokawa] suggests the hair care compositions for better combability and softness. Thus, both Meybeck and [Kurokawa] teach compositions for improving hair conditions and accordingly the motivation to combination [*sic*] the references flows logically. Therefore, a skilled artisan would have expected to improve the hair combing, softness while simultaneously treating the hair for graying by increased melanin production.

Id. at 5.

Appellants argue that the Examiner has failed to provide a proper suggestion or motivation for combining the references, and thus has failed to set forth a *prima facie* case of obviousness (Br.⁴ 5). We agree, and the rejection is reversed.

“[T]he Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. ‘[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” *In re*

⁴ All references to the Brief are to the Supplemental Appeal Brief dated February 3, 2006.

Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citation omitted).

Meybeck teaches (col. 1, ll. 12-17) “cosmetic or pharmaceutical, and in particular dermatological . . . compositions with pigmenting activity, capable of being used to accelerate the tanning of the skin, improve the complexion or retard the appearance of grey hair.” Meybeck teaches that “tyrosine or its derivatives, such as its salts or its esters, make it possible to obtain a measurable increase in the amount of melanin induced in the skin by ultraviolet rays when they are incorporated in a hydrated lipid lameller phase or in liposomes.” *Id.* at col. 2, ll. 13-18. With respect to retarding the appearance of grey hair, Meybeck teaches a lotion comprising a gelified suspension of the tyrosine containing liposomes, which is then applied to the scalp morning and evening. *See id.*, col. 8, ex. 8.

As noted by the Examiner, Kurokawa teaches at page 2 of the translation hair cosmetic compositions comprising quaternary ammonium conditioning compounds (cationic conditioning agents) and an amino acid selected from the group consisting of glycine, valine, histidine, tryptophan, threonine, *etc.* Kurokawa, however, teaches hair cosmetic compositions “which . . . treat the hair after washing.” *Id.* at page 2, first full paragraph. The compositions may be a “rinse type” or a “non-rinse type,” *id.*, and may be used in products such as a “hair rinse, spraying or dispenser type hair conditioner, hair lotion, etc.,” *id.* at 5, second full paragraph. In testing the composition, a bundle of hairs is shampooed, dried, and then treated with the composition according to the invention. *Id.* at 5, section entitled *Test Method.*

As set forth in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citations omitted):

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.”

...

Most if not all inventions arise from a combination of old elements. . . . Thus, every element of a claimed invention may often be found in the prior art. . . . However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. . . . Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

In other words, “there still must be evidence that ‘a skilled artisan, . . . with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.’”

Ecolochem Inc. v. Southern California Edison, 227 F.3d 1361, 1375, 56 USPQ2d 1065, 1075-76 (Fed. Cir. 2000). Contrary to the Examiner’s assertion, we find nothing on this record to suggest modifying the compositions of Meybeck and Kurokawa by adding a tyrosine ester to a hair conditioning product containing a quaternary conditioning compounds

(cationic conditioning agents) and an amino acid selected from the group consisting of glycine, valine, histidine, tryptophan, threonine, *etc.*

Meybeck teaches incorporating tyrosine or its derivatives into a liposome for the inducement of melanin formation when applied to the skin. Thus, Meybeck is treating the scalp, not the hair, whereas Kurokawa is drawn to conditioning the hair.

Moreover, the lotion of Meybeck containing the tyrosine ester needs to be applied directly to the scalp morning and evening, while the composition of Kurokawa is a conditioning agent for the hair. Although the tyrosine ester may reach the scalp if added to a hair conditioner, there is no evidence of record that hair conditioning agents are also massaged into the scalp such that sufficient amounts of the tyrosine ester would reach the scalp and be absorbed by the skin in a quantity sufficient to retard the appearance of grey hair. Thus, the Examiner has failed to set forth a *prima facie* case of obviousness, and the rejection is reversed.

The dissent's statement that the claims are not limited to applying the composition to the hair shaft and not the scalp misses the issue. The issue is whether there was motivation to combine Meybeck with Kurokawa, and for the reasons set forth above, we find that the combination is improper.

The dissent also asserts that the level of skill in the art of hair care has not been taken into account. While acknowledging that the product suggested by the combination may need be massaged into the scalp twice a day, the dissent argues that the art suggests a combination product that would provide retardation of the appearance of grey hair as well as improving combing properties and softness. However, as discussed above,

Meybeck teaches incorporating tyrosine or its derivatives into a liposome for the inducement of melanin formation when applied to the skin, and is thus drawn to the treatment of skin, in this case the scalp. Kurokawa, on the other hand, is drawn only to conditioning the hair, and in fact tests its product only on bundles of hair. Thus, we can find no motivation in the references to suggest the combination except Appellants' own disclosure

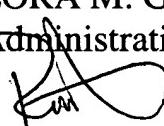
SUMMARY

Because the examiner has failed to set forth a prima facie case of obviousness, the rejection is reversed.

REVERSED



LORA M. GREEN
Administrative Patent Judge



RICHARD M. LEBOVITZ
Administrative Patent Judge

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LINCK, *Administrative Patent Judge*, Dissenting

I respectfully dissent. The Examiner's rejection should be affirmed for the reasons given by the Examiner, further elaborated below.

Appellants claim a "hair care composition" comprising "at least one ester derivative of tyrosine" and "at least one other amino acid compound selected from tryptophan compounds, histidine compounds and lysine compounds" and "a cosmetically acceptable carrier . . . suitable for use on hair . . . comprising one or more hair conditioning agents selected from the group consisting of silicone conditioning agents and cationic conditioning agents." Claim 1.

The Examiner has rejected claims 1-4 and 8-10 under § 103(a) based on U.S. 5,290,562 ("Meybeck") and JP 57-109711 ("Hideo"), each directed to a hair product. Appellants do not dispute that all the claim limitations are disclosed in these two references, if combined. Rather they argue:

There is no suggestion or motivation to combine the teachings of Meybeck and Hideo because the composition of Meybeck addresses a different problem and functions in a different manner than the composition of Hideo. . . .

. . . Example 8 of Meybeck expressly states that "[t]his lotion, applied morning and evening *to the scalp*, retards the appearance of grey hair (emphasis added [by Appellants]). Thus, the composition of Meybeck retards the appearance of grey hair by acting on the scalp. The composition of Meybeck does not act analogous to . . . a hair coloring composition which affects the color of the shaft of existing hair. . . .

In contrast . . . , the composition of Hideo provides benefits of improved combing properties and hair softness by targeting the shaft of the existing hair. . . . The composition of Hideo can be used as either a rinse-out or leave-in type

hair cosmetic. However, Hideo fails to teach or suggest applying the hair cosmetic composition to the . . . scalp such that benefits would be provided when the composition penetrates the epidermis. . . [Br. 5-6].

First, Appellants' arguments do not point to any claim language limiting the application of the composition to only the hair shaft and not the scalp. Nor is there any limitation on how many times the composition can be applied each day. *See the claims; see also Answer 6-7.*

Second (and perhaps more importantly), Appellants' arguments ignore the level of skill in the hair care art. Here, the art would have suggested making a combination product that would provide retardation of the appearance of grey hair and improved combing properties and softness. While such a product would likely require massaging the product into the scalp and perhaps application twice per day (as was done in Meybeck's Example 8 (col. 8, ll. 54-55)), claim 1 does not exclude such treatment. Thus, given the added benefits of the combination and the clear suggestion to the skilled artisan on what would be required to use the combination, I disagree with Appellants that one of ordinary skill in the art would not have been motivated to combine the hair products of Meybeck and Hideo.

I further note Appellants' specification states: "The compositions herein can contain a variety of optional components suitable for rendering the present compositions more cosmetically or aesthetically acceptable *or to provide them with additional usage benefits.*" Spec. at 11. Additionally I note the "composition may be applied in any suitable manner including, but not limited to . . . , working the composition onto the substrate [which includes skin], with the hands and fingers or with a suitable instrument" Spec. at 44.

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Thus, the Examiner's rejection of claims 1-4 and 8-10 should be affirmed.⁵



NANCY J. LINCK
Administrative Patent Judge

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⁵ Appellants do not argue the claims separately.

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